REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 26, 32 and 38 have been cancelled. Claims 1, 8, 9, 16, 17, 24, 30, 36 and 42 have been amended. Antecedent basis is located throughout Applicant's specification and the original claims, including FIGS. 1, 3n, 3o, 3p, 3q and 4, and the discussion at page 10 lines 10-16, page 17 lines 12-30, page 18 lines 1-13, and page 22 lines 1-21. Claims 1, 2, 5-10, 13-18, 21-24, 28-30, 34-36, 40-42 and 46-51 are pending.

Rejection of the claims

In the Office Action, independent claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,003,719 ("Rosenoff").

Claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper;
> at a first location within the electronic version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference at the first location is associated with a portion of the likeness, and wherein the detected reference at the first location is other than alphanumeric characters of the associated portion of the likeness; and
> in response to the detected reference at the first location, embedding a hyperlink within the associated portion of the likeness, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device.

In MPEP § 2131, the PTO provides that:

> *"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain a rejection of claim 1, Rosenoff must contain all of the above-recited elements in claim 1. However, Rosenoff fails to teach the combination of elements in claim 1. In fact, Rosenoff teaches away from such a combination.

Rosenoff "defines hyperlinks including at least a portion of the marked text" (see Abstract). In Rosenoff, "An exemplary implementation of the method finds and marks legal citations--for example, references to court opinions, government laws, and legal treatises--and automatically

defines each hyperlink to include at least a portion of a marked legal citation" (see col. 2 lines 43-48).

Unlike Rosenoff, claim 1 requires "wherein the detected reference at the first location is associated with a portion of the likeness, and wherein the detected reference at the first location is other than alphanumeric characters of the associated portion of the likeness; and in response to the detected reference at the first location, embedding a hyperlink within the associated portion of the likeness, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device."

Accordingly, Rosenoff fails to support a rejection of claim 1 under 35 U.S.C. § 102(e). In relation to claims 9 and 17, Rosenoff is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Rosenoff is defective in establishing a prima facie case of obviousness. As between Rosenoff and Applicant's specification, only Applicant's specification teaches the combination of elements in claim 1. In fact, Rosenoff teaches away from such a combination. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to claims 9 and 17, Rosenoff is likewise defective in establishing a prima facie case of obviousness. Accordingly, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Thus, a rejection of claims 1, 9 and 17 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 9 and 17.

Dependent claims 2, 5-8, 28-30, 46 and 47 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 10, 13-16, 34-36, 48 and 49 depend from and further limit claim 9 and therefore are allowable.

Dependent claims 18, 21-24, 40-42, 50 and 51 depend from and further limit claim 17 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 5-10, 13-18, 21-24, 28-30, 34-36, 40-42 and 46-51 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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